

REMARKS

Claims 36 and 37 have been canceled from this case. Thus, claims 1-35 remain pending in this application.

Claims 1-4, 9, 11-12, 14-18, and 20-35 have been rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent 5,151,321 to Reeves et al. (Reeves) in view of U.S. Patent 5,908,598 to Rousseau et al. (Rousseau). Applicants respectfully submit that this rejection cannot be sustained.

Reeves describes a method of making a conductive water and/or alcohol repellant nonwoven fabric. Water repellency/absorbency and surface electrical conductivity are controlled according to Reeves by contacting the webs with a composition that contains a single active compound that has a structural combination of conductive and repellant moieties. The nonwoven webs described in Reeves are disclosed as being especially suitable for medical applications and surgical uses. The nonwoven webs have controlled and desired levels of conductivity as well as water and alcohol repellency.

Rousseau describes a method of making a fibrous electret material, which comprises the steps of: forming a fibrous web of nonconductive thermoplastic fibers from a blend of nonconductive thermoplastic resin and an additive; impinging jets of water or a stream of water droplets onto the web at a pressure sufficient to provide it with filtration-enhancing electret charge, and drying the web. The additive may be one of compounds (a)-(c) as described in column 2, lines 51-57 and elsewhere through the Rousseau specification.

Applicants' invention pertains to a method of making a fibrous electret web. Applicants' invention comprises wetting a fibrous web with a wetting liquid, saturating the wetted web in an aqueous polar liquid, and then substantially drying the web. The web contains nonconductive polymeric fibers. The Reeves and Rousseau documents would not have made applicants' invention obvious to a person of ordinary skill for the following reasons.

Firstly, the combination of documents do not teach or suggest all of the elements of the present invention. In fact, the primary reference to Reeves does not even teach how to make an electret. Reeves is directed to treating fabrics to obtain electrical *conductivity*. Reeves starts with a nonconductive material and makes it conductive. Reeves desires to produce a conductive article to dissipate electric charge (see, for example, column 3, lines 46-51). The present invention, in contrast, is concerned with making an electret, which can only exist in a nonconductive material, which is a material that has a high-volume resistivity (see page 5, lines

1—2). The present invention seeks to retain electric charge, whereas Reeves wants to dissipate it. Reeves, therefore, is not suggesting how to produce electrets but instead is teaching in a direction opposite to the present invention. Even if we assume that a *prima facie* case of obviousness exists based on Reeves, it is rebutted when the art in any material aspect teaches away from the claimed invention.¹ A reference is said to teach away when a person of ordinary skill, upon reading the reference, is led in a direction divergent from the applicant's invention.²

Secondly, the secondary reference to Rousseau adds little or nothing to what is lacking in Reeves. Although Rousseau describes the production of an electret, it does not suggest doing so according to the steps of the present invention. Rousseau teaches imparting an electric charge to a nonwoven web by spraying it with jets of water. Rousseau does not teach or suggest the basic step of wetting the fibrous web with a wetting liquid prior to saturating it in an aqueous polar liquid. Thus, the combination of Reeves and Rousseau would not have made applicants' invention obvious to a person of ordinary skill.

Thirdly, even if Reeves and Rousseau did teach or suggest all the elements of the present invention, these two documents would not have rendered applicants' invention obvious to a person of ordinary skill because the record is devoid of any teaching or suggestion to combine their teachings. As the Examiner is aware, it is incumbent upon the United States Patent and Trademark Office to identify a teaching, suggestion, or motivation necessary for combining teachings from two separate and distinct documents.³ A probable reason that the record lacks this evidence is that Reeves and Rousseau are directed to fields that are manifestly different. As indicated above, Reeves is directed to a method of making a conductive nonwoven fabric, which is distinctly different from Rousseau where an electret is produced on a nonconductive article. As indicated above, Reeves is concerned with dissipating an electret charge, whereas Rousseau wants to preserve electric charge. The references accordingly have notably distinct goals.

For the above reasons, applicants respectfully submit that the obviousness rejection based on Reeves and Rousseau should be withdrawn from further consideration.

¹ *In re Geisler*, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997) ("A *prima facie* case of obviousness can be rebutted if the applicant...can show 'that the art in any material respect taught away' from the claimed invention.")

² *TecAir, Inc. v. Denso Mfg. Mich. Inc.*, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999).

³ *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1989).

Claims 1-2 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 5,705,219 to Besenhard et al. (Besenhard) in view of Rousseau. Applicants respectfully submit that this rejection also cannot be sustained.

Besenhard teaches a method for adhering carbon particles to the surface of a nonconductor. The coated particles can be conductive (column 4, lines 12-16). The thrust of Besenhard's teachings is to coat a surface with dispersed or suspended solid particles using an extremely small amount of binder (column 4, lines 12-16). The highly dispersed solid particles have properties that include catalytic activity and electrical conductivity. As indicated above with respect to Reeves, conductivity is not a desired aspect for carrying out the present invention. Thus, Besenhard's teaching in this regard leads a person of ordinary skill away from applicants' invention.

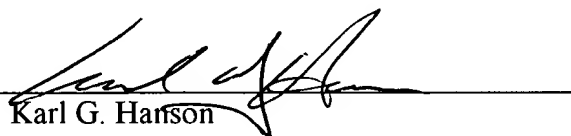
In addition, the record is also devoid of any teaching or suggestion to combine the teachings of Besenhard with Rousseau. The record does not present any evidence that a person of ordinary skill would have combined teachings in a document that pertains to coating surfaces with particulate materials with a document that is directed to producing fibrous webs that have enhanced electret properties. Without such a teaching, the present rejection cannot be sustained.

For these reasons, applicants believe that their invention is patentable over the art of record. Please favorably reconsider the rejections and allow this application at an early date.

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Respectfully submitted,

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